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## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

FRANCH, et al.

Serial No.: 10/549,619

Filed: February 28, 2006

For: LIGATIONAL ENCODING OF

Art Unit: 1623

Examiner:

October 10, 2006

Docket No.: FRANCH=4A

SMALL MOLECULES )
) Confirmation No.: 8187

## INFORMATION DISCLOSURE STATEMENT [IDS]

U.S. Patent and Trademark Office Customer Service Window Randolph Building 401 Dulany Street Alexandria, VA 22314

## sir:

This Information Disclosure Statement is submitted in accordance with 37 C.F.R. 1.97, 1.98, and it is requested that the information set forth in this statement and in the listed documents be considered during the pendency of the above-identified application, and any other application relying on the filing date of the above-identified application or cross-referencing it as a related application.

- 1. This IDS should be considered, in accordance with 37 C.F.R. 1.97, as it is filed:
- [] A. within three months of the filing date of the above-identified national application or within three months of the entry into the national stage of the above-identified international application. See 37 CFR 1.97(b)(1) and (3).
- [X] B. before the mailing date of a first office action on the merits. See 37 CFR 1.97(b).
- [] C. after (A) and (B) above, but before final rejection or allowance, and Applicants have made the necessary certification (box "i" below) or paid the necessary fee (box "i" below). See 37 CFR 1.97(c)(2).
  - [] i. Counsel certifies that, upon information and

belief, each item of information listed herein was either (a) cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this IDS or (b) was not cited in a communication from a foreign patent office in a counterpart foreign application and was not known to any individual designated in 1.56(c) more than three months prior to the filing of this IDS.

- [] ii. Credit Card Payment Form, PTO-2038, authorizing payment for the fee set forth in 1.17(p), presently believed to be \$180, is attached.
- [] D. after (A), (B) and (C) above, but before payment of the issue fee. Applicant petitions under 37 C.F.R. 1.97(d) for consideration of this IDS. A Credit Card Payment Form, PTO-2038, authorizing payment for the fee set forth in 1.17(p)(1), presently believed to be \$180 is attached. Counsel certifies that, upon information and belief, each item of information listed herein was either (i) cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this IDS or (ii) was not cited in a communication from a foreign patent office in a counterpart foreign application and was not known to any individual designated in 1.56(c) more than three months prior to the filing of this IDS.
- [] E. As a submission in accordance with the transitional procedure for limited examination after final rejection pursuant to 37 CFR §1.129(a). Pursuant to MPEP §706.07(g), page 700-66, col. 2 (August 2001), this IDS is treated as if filed with a period set forth in 37 CFR §1.97(b) and considered without the petition and petition fee required by 1.97(d).
- [ ] F. As a submission with or after a request for continued examination under CFR §1.114, and before the mailing of a first office action on the RCE. See 37 CFR §1.97(b)(4).
  - 2. In accordance with 37 C.F.R. 1.98, this IDS includes a

list (e.g., form PTO-1449) of all patents, publications, or other information submitted for consideration by the office, either incorporated into this IDS or as an attachment hereto. A copy of each document is attached, except as explained below.

- [] While an IDS filed under §1.97 must contain a "list of all patents, publications or other information submitted for consideration by the Office", see §1.98(a) (1), the only requirement for the list is that it provide the information set forth in §1.98(b). There is no requirement that a form PTO-1449 be used (MPEP §609 merely says that use of this form is "encouraged"). Counsel has used a list provided to him by Applicants, and not transferred the information to a PTO-1449, to avoid the risk of any inadvertent error in transferring the information.
- [X] A. Documents <u>AA-BJ</u> are U.S. Patents or U.S. Patent Publications, and hence copies of these documents have not been provided. See 37 CFR 1.98(a)(2)(ii).
- [] B. Documents \_\_\_\_\_ are deemed substantially cumulative to documents \_\_\_\_\_, and, in accordance with 1.98(c), only a copy of each of the latter documents is enclosed.
- [] C. Certain documents were previously cited by or submitted to the Office in the following prior application(s), which are relied upon under 35 U.S.C. 120:

[insert serial number/filing date]

Applicants identify these documents by attaching hereto copies of the form PTO-892s and PTO-1449s from the files of the prior applications or a fresh PTO-1449 listing these documents, and request that they be considered and made of record in accordance with 1.98(d). Per 37 CFR 1.98(d), copies of these documents need not be filed in this application. If copies of any of these documents cannot be found in the files of the prior applications, the Examiner is requested to so notify counsel <u>before</u> taking action in this case, so replacement copies can be submitted. While an IDS filed under §1.97 must contain a "list of all patents, publications or other information submitted for

consideration by the Office", see §1.98(a) (1), the only requirement for the list is that it provide the information set forth in §1.98(b). There is no requirement that a form PTO-1449 be used (MPEP §609 merely says that use of this form is "encouraged") and no prohibition on submitting a copy of a form PTO-1449 or form PTO-892 from a prior case. Indeed, the re-use of such forms is desirable as it avoids error in transferring the information, and evidences that the reference was considered in a prior application. A previously accepted PTO-1449, or an examiner-prepared PTO-892, necessarily complies with §1.98(b).

or such forms is de	sirable as it avoids error in transferring the
information, and ev	ridences that the reference was considered in
a prior applicatio	on. A previously accepted PTO-1449, or a
examiner-prepared 1	PTO-892, necessarily complies with §1.98(b).
[] 3. Docume	ents are not in the English language
In accordance with	1.98(a)(3), Applicants state:
[ ] documents	already contain an Englis
language a	abstract, summary or claim set.
[ ] a publicl	y available abstract is attached to each o
documents	, and the source of each abstract is
indicated	thereon.
[ ] documents	are publicly available English
language a	abstracts of foreign language patents. If the
Examiner	would like us to obtain a copy of the
underlying	g document, with or without a translation
s/he shou	ld contact Counsel.
[] documents	are patents or published patent
application	ons for which counterpart English language
patents or	patent applications exist, and are enclosed
as follows	3:
Foreign 1	Lang. Doc.# English Lang. Doc.#
[insert]	[insert]
[] applicants	s have prepared an English translation of a
least the	pertinent portions of documents
and copies	s are attached.
[] A concise	explanation of the relevance of documents
	is found in the attached search report from
the	Patent Office (see reply to Comment 68 in
the pream	ole to the final rules; 1135 OG 13 at 20).

- [ ] A concise explanation of the relevance of documents \_ appears in the present specification.
- [ ] A concise explanation of the relevance of documents \_\_\_\_\_ is set forth as follows:

[Insert concise explanation of relevance]

- 4. No explanation of relevance is necessary for documents in the English language (see reply to Comments 67 and 68 in the preamble to the final rules; 1135 OG 13 at 20).
- 5. If the month of publication of a nonpatent reference is not stated, it is because it is not apparent from review of the reference. If requested to do so by the Examiner, Applicants will attempt to locate and write to the publisher.

If the publication date of a cited document is set forth only as a publication year, and that year is prior to the year of filing or, if priority is claimed, year of priority of this application, then the particular month of publication is not in issue. Likewise if that publication year is after the year of filing of this application, the month of publication is not in issue.

If the date of publication of a nonpatent reference is stated, then, except as explained below, it is the nominal date stated in the reference, or in a larger document (journal or book) from which the reference was extracted. Applicants reserve the right to challenge this date by contacting the publisher to determine the actual shipment date, or by contacting recipients to determine the receipt dates.

6. Other information being provided for the examiner's consideration follows:

[insert other information]

7. In accordance with 37 C.F.R. 1.97(g) and (h), the filing of this IDS should not be construed as a representation that a search has been made or that information cited is, or is considered to be, material to patentability as defined in §1.56 (b), or that any cited document listed or attached is (or constitutes) prior art. Unless otherwise indicated, the date of

## USSN - 10/549,619

publication indicated for an item is taken from the face of the item and Applicant reserves the right to prove that the date of publication is in fact different.

8. The Commissioner is hereby authorized and requested to charge any additional fees which may be required in connection with this paper or credit any overpayment to Deposit Account No. 02-4035.

Respectfully submitted,

BROWDY AND NEIMARK, P.L.L.C.

Attorneys for Applicant

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TRADEMIN'S INFORMATION DISCLOSURE STATEMENT LIST OF DOCUMENTS CITED BY APPLICANT

ATTY DOCKET NO: FRANCH=4A

**SERIAL NO: 10/549,619** 

FIRST INVENTOR: FRANCH, Thomas

**ART UNIT: 1623** FILING DATE: February 28, 2006

U.S. PATENT DOCUMENTS (include at least patentee, patent number and issue date) **EXAMINER** FILING DATE **DOCUMENT NUMBER** DATE **PATENTEE** IF APPROP. INITIAL Kurz, M et al. AA 2 9 3 0 0 Aug 6, 2002 6 2 O Mar 27, 2001 AB 4 6 Szostak, J et al. AC 0 3 Nov 7, 2000 6 1 3 5 Baskerville, DS et al. May 28, 1998 AD 6 6 2 Ō 5 8 Sept 16, 2002 Taussig, MJ et al. 03 April 4, 2001 20 00 04 Jan 2, 2003 Beigelman et al. 8 Jul 15, 2003 Aug 24, 2000 AF 6 5 9 3 0 8 Saito, I et al. Nov 5, 1991 AG 5 5 1 g 0 3 Gryaznov,SM et al. 5 9 Dec 19, 1995 AH 6 ō Letsinger, RL et al. Oct 28, 1997 ΑI 5 6 8 9 3 Letsinger, RL et al. AJ 5 7 8 0 6 1 3 Jul 14, 1998 Letsinger, RL et al. Apr 21, 1998 AK 5 4 1 6 4 3 Gryaznov, SM et al. 5 8 3 ō 6 5 8 Nov 3, 1998 Gryaznov, SM et al. AL 5 Dec 1, 1998 AM 5 8 4 3 6 O Segev, D 5 5 0 3 8 0 5 Apr 2, 1993 AN Sugarman et al. AO 5 6 3 9 6 O 3 Jun 17, 1997 Dower et al. Sep 9, 1997 AP 5 6 6 5 9 7 5 Kedar et al. AQ 5 0 8 1 5 3 Jan 13, 1998 Dower et al. 7 5 AR 5 0 3 8 Jun 23, 1998 Dower et al. AS 5 7 8 9 6 2 Aug 4, 1998 Dower et al. May 2, 2000 July 23, 1996 0 2 6 ÄΤ 6 5 6 9 Sugarman et al. AU 6 1 4 0 4 9 3 Oct 31, 2000 Dower et al. Sept 11, 1998 Mar 6, 1998 Áν 6 4 3 4 9 Nov 2, 2000 Dower et al. May 13, 1998 AW 6 1 6 5 1 7 Dec 26, 2000 Dower et al. AX 6 1 6 5 8 Dec 26, 2000 Jul 2, 1998 Kedar et al. AY 6 9 4 9 July 9, 2002 Feb 24, 1999 4 1 6 Dower et al. ΑZ 5 5 3 9 0 5 Nov. 12, 1996 Lerner, RL et al. BA 5 7 9 8 Mar 3, 1998 Lerner, RL et al. May 9, 2000 Mar 3, 1998 BB 6 0 6 ō 5 9 6 Lerner, R et al. BC 4 8 2 2 3 1 April 18, 1989 Watson et al. BD 6 2 9 7 0 5 October 2, 2001 Stemmer 3 05 იი 25 6 6 February 2, Liu et al. BE 20 7 2005 BF 20 05 ດດ 6 9 February 24, Liu et al. 42 6 2005 20 05 00 42 6 6 9 Published 24 Liu, David R BG February 2005 20 05 00 25 6 6 ВН Published 3 Liu, David R

DATE CONSIDERED **EXAMINER**: initial if reference considered. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

February 2005

30 June 2005

4 Aug 2005

Liu, David R

Liu, David R

SUBSTITUTE FOR FORM IPC/SB/08					ATTY DOCKET NO: FRANCH=4A		SERIAL NO: 10/549,619						
INFORMATION DISCLOSURE STATEMENT LIST OF DOCUMENTS CITED BY APPLICANT FIR					FIRST INVENT	FIRST INVENTOR: FRANCH, Thomas							
					FILING DATE: February 28, 2006			ART UNIT: 1623					
FOREIGN PAT	FOREIGN PATENT DOCUMENTS (include at least document number, publication date and country)												
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	TM 21	1	5	3	3	3	8	5	25 May, 2005	EP			
	TM 22	20	05	00	3	7	7	8	13 Jan 2005	PCT		<u> </u>	
	TM 23	20	04	03	9	8	2	5	13 May 2004	PCT			
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	СН	9	6	0	9	3	1	6	March 28, 1996	PCT			
	CI	0	0	2	1	9	0	9	April 20, 2000	PCT			
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EXAMINER													
11	<b>EXAMINER:</b> Initial if reference considered. Draw line through citation if not in conformance <u>and</u> not considered. Include copy of this form with next communication to applicant.												

SUBSTIT	UTE FOR	R FORM IPC/SB/08	ATTY DOCKET NO: FRANCH=4A	SERIAL NO: 10/549,619				
INFORMATION DISCLOSURE STATEMENT LIST OF DOCUMENTS CITED BY APPLICANT			FIRST INVENTOR: FRANCH, Thomas					
	<u></u>		FILING DATE: February 28, 2006	ART UNIT: 1623				
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EXAMI		itial if reference considered. Draw line through cit ext communication to applicant.	ation if not in conformance and not considered. Inc	clude copy of this form				

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